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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,531	01/07/2005	Shinsuke Sugata	KAS.066	9239

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EXAMINER
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GATES, ERIC ANDREW

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/520,531	<b>Applicant(s)</b> SUGATA ET AL.	
	<b>Examiner</b> Eric A. Gates	<b>Art Unit</b> 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☒ Claim(s) 5-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☒ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/7/05</u> . | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 19 July 2002. It is noted, however, that applicant has not filed a certified copy of the 2002-209894 application as required by 35 U.S.C. 119(b).

### ***Information Disclosure Statement***

2. The information disclosure statement filed 7 January 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Drawings***

3. Figure 11 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The abstract of the disclosure is objected to because included drawing reference numbers are not enclosed in parentheses. Correction is required. See MPEP § 608.01(b).

5. The disclosure is objected to because of the following informalities: on page 1, line 14, the errant letter "f" should be removed.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation "the mist cutting fluid passages open to the atmosphere" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Uchida et al. (U.S. Patent 5,649,714).

10. Regarding claim 1, Uchida et al. discloses a tool holder 6 of a machine tool, comprising: a holder body 3; a tool receiving surface part 11 for receiving a rear end face of a shaft-like tool 1 so as to form a closed space (not labeled, between surface 11b and tool 1 in figure 7) in contact with the rear end face, said shaft-like tool being fixed on a front end of the holder body; and mist cutting fluid passages 10/9a/11a for leading mist cutting fluid fed from a front end part of a spindle (not labeled, see figure 1) to the closed space; wherein an exhaust passage 1c is formed for opening the closed space to the atmosphere, said exhaust passage being in addition to a passage 1c (other passage 1c, i.e., not exhaust passage 1c above) of the shaft-like tool in communication with the closed space.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Ronen (U.S. Patent 5,028,178).

13. Regarding claim 1, Ronen discloses a tool holder 1 of a machine tool, comprising: a holder body 1; a tool receiving surface part 2 for receiving a rear end face of a shaft-like tool 4 so as to form a closed space (not labeled, formed by hollow bores of body 1 and part 2 and end of tool 4, see figure 1) in contact with the rear end face, said shaft-like tool being fixed on a front end of the holder body; and cutting fluid passages (not labeled as such, but area where cutting fluid C flows in bore of body 1 in figure 1) for leading cutting fluid C fed from a front end part of a spindle (not shown, but inherent to the use of the tool holder for drilling) to the closed space; wherein an exhaust passage A is formed for opening the closed space to the atmosphere, said exhaust passage being in addition to a passage 4' of the shaft-like tool in communication with the closed space. Ronen does not distinctly disclose using a mist form of cutting fluid, however Examiner takes official notice that it is well known in the art to substitute mist cutting fluid for oil in the art, as shown by Uchida et al. above.

14. Regarding claim 2, the modified invention of Ronen discloses wherein said exhaust passage A has a circular portion near a center of rotation of the closed space, concentrically outside the mist cutting fluid passages open to the atmosphere (especially cutting fluid passages on left portion of figure 1).

15. Regarding claim 3, Ronen discloses a tool holder 1 of a machine tool, comprising: a holder body 1; a tool receiving surface part 2 for receiving a rear end face

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of a shaft-like tool 4 so as to form a closed space (not labeled, formed by hollow bores of body 1 and part 2 and end of tool 4, see figure 1) in contact with the rear end face, said shaft-like tool being fixed on a front end of the holder body; and cutting fluid passages (not labeled as such, but area where cutting fluid C flows in bore of body 1 in figure 1) for leading cutting fluid C fed from a front end part of a spindle (not shown, but inherent to the use of the tool holder for drilling) to the closed space; wherein said tool receiving surface part 2 is excavated rearward (bore of part 2 continues rearward from end of tool 4) to form an excavated part large in diameter (where part 2 ends in bore of holder 1), a front end part of said cutting fluid passages protrudes so as to form a circular space between a peripheral wall 7 and the excavated part, and wherein an exhaust passage A is formed for opening a circular portion concentrically outside the mist cutting fluid passages near a center of rotation of the rear end face of the excavated part to the atmosphere. Ronen does not distinctly disclose using a mist form of cutting fluid, however Examiner takes official notice that it is well known in the art to substitute mist cutting fluid for oil in the art, as shown by Uchida et al. above.

16. Regarding claim 4, the modified invention of Ronen discloses wherein said tool receiving surface part 2 forms a front end face of a tool receiving member 2 adjustable in longitudinal position in the holder body 1 (adjustable by removing and installing).

***Allowable Subject Matter***

17. Claims 5-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is 571-272-5498. The examiner can normally be reached on Monday-Thursday 7:45-6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EAG  
2 April 2006



BOYER D. ASHLEY  
SUPERVISORY PATENT EXAMINER